

REMARKS/ARGUMENTS

In response to the Office Action dated May 5, 2004, claims 1, 10 and 14 are amended. Claims 1-18 are now active in this application. No new matter has been added.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-5, 10 and 14-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In support of this position, the Examiner contends that “each group including the translated document data translated in a common language that is different from each other group” is vague and indefinite.

The rejection of claims 6-18 is respectfully traversed.

Case law precedent has established that an analysis under 35 U.S.C. § 112 begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is viewed not in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be interpreted by one possessing the ordinary level of skill in the art. *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification, *Seattle Box Co. v Industrial Crating & Packing*, 731 F.2d 381, 385, 221 USPQ 568, 574 (Fed. Cir. 1984).

In determining definiteness, no claim may be read apart from and independent from the disclosure on which it is based. *In re Cohn*, 169 USPQ 95, 98 (CCPA 1971); *In re Kroekel*, 183 USPQ 610, 612 (CCPA 1974):

... claims are not to be considered in a vacuum, "but always in light of the teachings of the prior art and the particular application disclosure as it would be viewed by one possessing the ordinary level of skill in the pertinent art." When considered in light of the prior art and the specification, claims otherwise indefinite may be found reasonably definite.

The Examiner's problem concerning "each group including the translated document data translated in a common language that is different from each other group" results from the fact that the Examiner is reading the claims in a vacuum and not in light of the specification. It is submitted that when the claim language is read in light of the specification, an artisan would readily understand the metes and bounds of the invention and in particular, that the phrase should be read that "each language group including the translated document data translated into a common language that is different from the common language that the translated document data is translated into in each other language group"

At any rate to expedite prosecution, claim 1 is amended to recite, *inter alia*:

... each language group including the translated document data translated into a common language that is different from the common language that the translated document data is translated into in each other language group.

Claim 10 is amended to recite, *inter alia*:

... and controls said output unit so as to output the plurality of translated languages by groups, the translated language of each group being different from one another.

Claim 14 is amended to recite, *inter alia*:

... and controls said output unit so as to output the document data translated into the first and second languages as a common group, said controller further controls said output unit to repeatedly output the common group by the number ~~to be output~~ set by said operation unit.

Amended claims 1, 10 and 14 are believed to recite the invention with the degree of precision and particularity required by the statute. Therefore, it is respectfully urged that the rejection of claims 1-5, 10 and 14-16, as being indefinite, be withdrawn.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 103

Claims 1-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Yamauchi et al. (USPN 5,701,497) in view of Flores et al. (USPN 6,370,498) for the reasons of record..

The rejections are respectfully traversed.

In imposing a rejection under 35 U.S.C. §103, the Examiner is charged with the initial burden of identifying a source in the applied prior art for: (1) *claim limitations*; and (2) the requisite motivation to combine references with a reasonable expectation of achieving a specific result. *Smiths Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). That burden has not been discharged.

Yamauchi et al. discloses that a received document written in a first language is translated into a second language, different from the first language, and then outputted. In other words, Yamauchi et al. discloses that a document written in a first language and a translated document written in a second language are printed.

Simultaneously printed in Yamauchi et al. at the time of outputting are documents in the first language and second language. That is, the document to be translated and the translated document are simultaneously outputted. Furthermore, Yamauchi et al. intends to output only

two documents, i.e., the document to be translated and the translated document. Accordingly, in the example of the simultaneous outputting, the document to be translated and the translated document are printed on the front side and back side of the paper, respectively (see column 4, lines 53-60, column 20 lines 32-column 21 line 28, Figs. 24 and 25).

If it is assumed that Flores et al. teaches that a language is translated into a plurality of languages, and such teaching were applied to Yamauchi et al. along the Examiner's theory, the following structure will result:

In the case where the teaching of Flores et al. that a document to be translated (hereinafter referred to as "original document") is translated into different languages (e.g., "first translated document" and "second translated document") is applied to the device disclosed in Yamauchi et al., since Yamauchi et al. discloses that an original document and a translated document are simultaneously outputted as mentioned above (the document to be translated and the translated document are printed on the front side and back side of the paper), a structure would result in which the original document and the first translated document are simultaneously outputted and that the original document and the second translated document will be simultaneously outputted.

In contrast, in the present invention (the second mode of claim 1), using the aforementioned example, the first document and the second document are outputted as a group.

In short, even if the teaching of Flores et al. were combined with the arrangement of Yamauchi et al. and Flores et al., since neither of these references teaches a concept that translated documents are outputted as a group, the present invention (claims 1, 14) does not result.

Regarding claims 6, 11 and 17, they are directed to a unification mode (Figs. 4 and 5) in the embodiment in which a document to be translated includes a plurality of languages which will be translated into at least one language and the translated document is outputted. Neither Yamauchi et al. nor Flores et al. discloses or suggests that *a document including a plurality of languages is translated into at least one language and then the translated document is outputted.*

It is, therefore, respectfully submitted that the Examiner did not establish a *prima facie* basis to deny patentability of the claimed invention under 35 U.S.C. § 103 for want of the requisite factual basis. Specifically, the Examiner has failed to identify a source in the applied prior art references for every claim limitation. Accordingly, withdrawal of the Examiner's rejection of claims 1-18 under 35 U.S.C. § 103 is respectfully solicited.

CONCLUSION

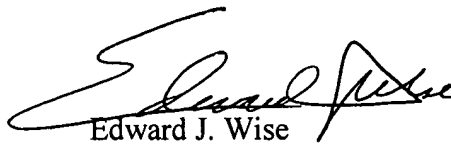
Accordingly, it is urged that the application, as now amended, overcomes the rejection of record and is in condition for allowance. Entry of the amendment and favorable reconsideration of this application, as amended, are respectfully requested. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

09/593,060

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Edward J. Wise", is written over the printed name.

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Date: July 22, 2004